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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,507	02/23/2004	Ken Rosenblum	1326.001US5	1482
21186	7590	08/10/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938			MAI, THIEN T	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,507	<b>Applicant(s)</b> ROSENBLUM, KEN	
	<b>Examiner</b> Thien T. Mai	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Content of Specification

1. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims.

2. The abstract of the disclosure is objected to because number of words exceeds the maximum number of 150 words. Correction is required. See MPEP § 608.01(b).

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim(s) 1-4, 6-11 is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 5, 9, 15 of U.S. Patent No. 6,892,941

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(Patent '941 hereafter) and claim 1 of U.S. Patent No. 6,697,704 (Patent '704). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention has been recited in patented inventions by applicant.

Regarding claim 1, Patent '941 recites a method comprising

- Sending prescription information for a medication (claim 3), inherently known to include therapeutic agent, to a dispensing apparatus (claim 5)
- Giving the patient a one-time unique authorization code (claims 5, 15)
- The patient entering the “a one-time, unique, prescription-specific” authorization code (see claim 5) unique to the singular prescription (claim 3 of Patent '704), inherently implies the code having no capability of being reused.
- The patient receiving medication, inherently known to include therapeutic agent, from the dispensing apparatus (claim 3)

Regarding claim 2, Patent '941 recites an automatic dispensing machine capable of delivering filled prescription container to a customer outside the enclosed pharmacy floor space in response to customer request (claim 3) and requires no pharmacist intervention (claim 9).

Regarding claim 3 and 4, Patent '941 recites the unique authorization code being given by pharmacy service providers (claim 15) working in the enclosed pharmacy floor space (claim 3), which inherently implies that pharmacy service providers are people known as health care provider and pharmacy technician and/or pharmacist.

Regarding claim 6, see discussion regarding claim 1.

Regarding claim 7, Patent '941 recites a method comprising

- Providing the dispenser with filled prescription, inherently including therapeutic products, containers in the dispenser being retrieved (claim 4 of Patent '941).
- Transmitting a proposed prescription to a self-service server from a remote pharmacist (claim 1 of Patent '704).

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- Authorizing dispensing of at least a portion of the prescription in the dispenser (claim 1 of Patent '704)
- Providing unique authorization code (claim 3 of Patent '704)
- The patient entering the authorization code into the dispenser (claim 5 of Patent '941)
- Dispenser delivering the therapeutic product (claim 3 of Patent '941)

Regarding claim 8, Patent '704 recites the authorization being done without intervention of a pharmacist (claim 2 of Patent '704).

Regarding claim 9, see discussion regarding claim 2.

Regarding claim 10 and 11, see discussion regarding claims 3 and 4.

5. Claim(s) 12-16 is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 of U.S. Patent No. 6,892,941 (Patent '941 hereafter), claim 1 of U.S. Patent No. 6,529,801 (Patent '801), and claim 1 of U.S. Patent No. 6,697,704 (Patent '704). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention has been recited in patented inventions by applicant.

Regarding claim 12, Patent '941, Patent '704, and Patent '801 recites a method comprising:

- Providing a dispenser containing therapeutic products (claim 1 of Patent '704)
- Adjudicating a proposed prescription (claim 1 of Patent '801)
- Authorizing dispensing at least a portion of adjudicated prescription (claim 1 of Patent '801), authorization is done without pharmacist intervention (claim 2 of Patent '704)
- Patient inputting data at the dispenser (claim 5 of Patent '941)
- Dispenser delivering therapeutic product to the patient (claim 3 of Patent '941)

Regarding claim 13 and 14, see discussion regarding claim 1.

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Regarding claim 15, see discussion regarding claim 2.

Regarding claim 16, Patent '801 recites adjudicating of the proposed prescription is done by the server, inherently implies no intervention of a pharmacist necessary (claim 1).

6. Claim(s) 5 is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 of U.S. Patent No. 6,892,941 (Patent '941), in view of Liff (6283322)

Regarding claim 5, Patent '941 recites all limitations set forth in this claim as discussed above except for the patient to pay for at least a portion of the therapeutic agent at the dispenser. Liff's invention discloses the patient will get the packaged medical product from the dispenser if a payment is authorized (claim 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Patent '941 and Liff to automate the payment mechanism for the therapeutic agent.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Thien T Mai  
Examiner  
Art Unit 2876

August 04, 2005



**THIEN M. LE**  
**PRIMARY EXAMINER**